



JG82 Rec'd PCT/PTO 22 APR 2002

PTO/SB/21 (08-00)

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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

|  |  |                        |               |
|--|--|------------------------|---------------|
|  |  | Application Number     | 10/069,223    |
|  |  | Filing Date            | 08/10/2000    |
|  |  | First Named Inventor   | CLARKE et al. |
|  |  | Group Art Unit         |               |
|  |  | Examiner Name          |               |
| Total Number of Pages in This Submission |  | Attorney Docket Number | 11696.0047    |

### ENCLOSURES (check all that apply)

|  |   |  |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form                                | <input type="checkbox"/> Assignment Papers (for an Application)                         | <input type="checkbox"/> After Allowance Communication to Group                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences        |
| <input type="checkbox"/> Amendment / Reply                                   | <input type="checkbox"/> Licensing-related Papers                                       | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final   | <input type="checkbox"/> Petition   | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Status Letter   |
| <input type="checkbox"/> Extension of Time Request                           | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):            |
| <input type="checkbox"/> Express Abandonment Request                         | <input type="checkbox"/> Terminal Disclaimer  | PTO-1449   |
| <input checked="" type="checkbox"/> Information Disclosure Statement         | <input type="checkbox"/> Request for Refund   | Cited references   |
| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> CD, Number of CD(s) _____                                      |  |
| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application   |   |  |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |
| Remarks  |   |  |

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

|                         |   |
|-------------------------|---|
| Firm or Individual name | STEP TOE & JOHNSON LLP<br>Scott D. Watkins, Reg. No. 36,715 |
| Signature               |   |
| Date                    | 4/18/02   |

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date:

|                       |      |
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| Typed or printed name |      |
| Signature             | Date |

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Patent Application  
Atty. Dkt. 11696.0047

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Group Art Unit: Not Yet Assigned

CLARKE et al.

Examiner: Not Yet Assigned

Serial No.: 10/069,223

Filed: August 10, 2000

For: SYSTEM AND APPARATUS FOR  
AVOIDING INTERFERENCE  
BETWEEN FIXED AND MOVABLE  
BASE TRANSCEIVER STATION

**INFORMATION DISCLOSURE STATEMENT**

Assistant Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

The undersigned hereby submits the attached form PTO 1449, as well as copies of the documents cited therein. The following provides a summary of the accompanying documents, grouped by document type:

|  |   |
|--|---|
| 4,774,514 (Hildebrandt et al.)                 | WO 99/12227 (PCT)                         |
| 5,438,610 (Bhagat et al.)                      | 2,320,992 (United Kingdom)                |
| 5,490,284 (Itoh et al.)                        | WO 98/26521 (PCT)                         |
| 5,519,761 (Gilhousen)                          | WO 94/28684 (PCT)                         |
| 5,577,264 (Tuohino)                            | 2,310,973 (United Kingdom)                |
| 5,842,132 (Fukutomi)                           | WO 97/37500 (PCT)                         |
| 5,887,258 (Lemozit et al.)                     | 2,169,175 (United Kingdom)                |
| 5,950,129 (Schmid et al.)                      | EP 0 862 283 (Europe)                     |
| 5,963,877 (Kobayashi)                          | WO 99/62274 (PCT)                         |
| 6,002,944 (Beyda)                              | EP 0 923 257 (Europe)                     |
| 6,269,243 (Corbefin et al.)                    | WO 98/21838 (PCT)                         |
| Suzuki et al., "Call Routing..."               | 2,324,395 (United Kingdom)                |
| Uchiyama et al., "Network Functions..."        | WO 99/62274 (PCT)                         |
| Nodera et al., "Interworking..."               | WO 01/15337 (PCT)                         |
| GSM World Press Release, "GSM..."              | EP 0 936 829 (Europe)                     |
| Fernandez et al., "Le TFTS..."*                | 2,282,299 (United Kingdom)                |
| BTtoday NEWSDESK website, "Lift off..."        | WO 97/36442 (PCT)                         |
| Beresford, "Office in the sky..."              | EP 0 915 577 (Europe)*                    |
| International Search Report for PCT/IB01/00830 | FR 2,773,931 (France)* (see US 6,269,243) |
| International Search Report for PCT/GB00/03074 | EP 0 838 909 (Europe)* (see US 5,887,258) |
|  | EP 0 932 266 (Europe)* (see US 6,269,243) |
|  | EP 0 920 147 (Europe)*                    |

\* Foreign language document.

International Search Report for PCT/GB00/03087  
International Search Report for PCT/IB01/00811  
International Search Report for PCT/GB00/03088  
International Search Report for PCT/IB01/00802

With respect to the foreign language documents, EP0915577, EP0920147, and EP0932266 are accompanied by English translations; Fernandez *et al.* and FR2773931 are relevant via their citations in a search report for related application PCT/GB00/03087; and EP0838909 is relevant via its citation in related application PCT/GB00/03074. The noted search reports are submitted herewith.

The Fernandez *et al.* reference lacks a month of publication, but the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not an issue. See MPEP §609 III(A)1.

Applicants bring the following co-pending applications to the attention of the examiner: 09/830,207; 09/833,594; 09/832,973; 09/832,879; 09/833,593; and 10/069,100. The examiner is invited to review the files for these applications and any art cited therein.

It is respectfully requested that the references be expressly considered during the prosecution of this application and made of record herein and among the "References Cited" on any patent to issue herefrom. Consideration of the foregoing and enclosures, plus the return of the enclosed form PTO-1449 with the Examiner's initial in the left-hand column (per MPEP 609), are earnestly solicited.

This Information Disclosure Statement is intended to be in full compliance with the Rules, but should the Examiner find any part of its required content to have been omitted, prompt notice to the effect is earnestly solicited, along with additional time under Rule 97(f), to enable full compliance.

The Commissioner is hereby authorized to charge any fee associated with this request or credit any overpayment to Deposit Account No. 19-4293 (Order No. 11696.0047). A duplicate of this communication is enclosed for accounting purposes.

Respectfully submitted,



Scott D. Watkins  
Reg. No. 36,715

Date: 4/18/02

Steptoe & Johnson LLP  
1330 Connecticut Ave., N.W.  
Washington, DC 20036  
(202) 429-6439

Date Mailed: April 22, 2002

APR 22 2002

Sheet 1 of 2

FORM 1449 (S&amp;J Version)

**INFORMATION DISCLOSURE STATEMENT  
BY APPLICANT**

|                             |                 |
|-----------------------------|-----------------|
| Docket No.: 11696.0047      |                 |
| Applicant: CLARKE et al.    |                 |
| Application No.: 10/069,223 |                 |
| Filing Date: 08/10/2000     |                 |
| Examiner:                   | Group Art Unit: |

**U.S. PATENT DOCUMENTS**

| Examiner's Initials* | Document No. | Date MM/YYYY | Inventor           | Class | Subclass | Filing Date If Appropriate |
|----------------------|--------------|--------------|--------------------|-------|----------|----------------------------|
|                      | 4,774,514    | 09/1988      | Hildebrandt et al. |       |          |                            |
|                      | 5,438,610    | 08/1995      | Bhagat et al.      |       |          |                            |
|                      | 5,490,284    | 02/1996      | Itoh et al.        |       |          |                            |
|                      | 5,519,761    | 05/1996      | Gilhousen          |       |          |                            |
|                      | 5,577,264    | 11/1996      | Tuohino            |       |          |                            |
|                      | 5,842,132    | 11/1998      | Fukutomi           |       |          |                            |
|                      | 5,887,258    | 03/1999      | Lemozit et al.     |       |          |                            |
|                      | 5,950,129    | 09/1999      | Schmid et al.      |       |          |                            |
|                      | 5,963,877    | 10/1999      | Kobayashi          |       |          |                            |
|                      | 6,002,944    | 12/1999      | Beyda              |       |          |                            |
|                      | 6,269,243    | 07/2001      | Corbefin et al.    |       |          |                            |
|                      |              |              |                    |       |          |                            |
|                      |              |              |                    |       |          |                            |
|                      |              |              |                    |       |          |                            |
|                      |              |              |                    |       |          |                            |

**FOREIGN PATENT DOCUMENTS**

| Examiner's Initials* | Document No. | Date MM/YYYY | Country        | Class | Subclass | Translation |    |
|----------------------|--------------|--------------|----------------|-------|----------|-------------|----|
|                      |              |              |                |       |          | Yes         | No |
|                      | WO 99/12227  | 03/1999      | PCT            |       |          |             |    |
|                      | 2,320,992    | 07/1998      | United Kingdom |       |          |             |    |
|                      | WO 98/26521  | 06/1998      | PCT            |       |          |             |    |
|                      | WO 94/28684  | 12/1994      | PCT            |       |          |             |    |
|                      | 2,310,973    | 09/1997      | United Kingdom |       |          |             |    |
|                      | WO 97/37500  | 10/1997      | PCT            |       |          |             |    |
|                      | 2,169,175    | 07/1986      | United Kingdom |       |          |             |    |
|                      | EP 0 862 283 | 09/1998      | Europe         |       |          |             |    |
|                      | WO 99/62274  | 12/1999      | PCT            |       |          |             |    |
|                      | EP 0 923 257 | 06/1999      | Europe         |       |          |             |    |
|                      | WO 98/21838  | 05/1998      | PCT            |       |          |             |    |
|                      | 2,324,395    | 10/1998      | United Kingdom |       |          |             |    |
|                      | WO 99/62274  | 12/1999      | PCT            |       |          |             |    |
|                      | WO 01/15337  | 03/2001      | PCT            |       |          |             |    |

**OTHER DOCUMENTS**

|                      |   |
|----------------------|---|
| Examiner's Initials* | Include author, title of article, title of item (book, journal, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.  |
|                      | Suzuki et al., "Call Routing and Data Model for Inter-Network Roaming in PCS", IEICE TRANS. COMMUN., Vol. E79 B. No. 9, September 1996, pp. 1371-1379.  |
|                      | Uchiyama et al., "Network Functions and Signaling for Personal Roaming between Digital Cellular Standards", IEEE International Conference on Universal Personal Communications, New York, IEEE, vol. CONF. 4, November 1995, pp. 447-451.               |
|                      | Nodera et al., "Interworking between GSM and PDC through IC Cards", Proceedings of the Conference on Communications (ICC), New York, IEEE, June 1995, pp. 761-765.  |
|                      | GSM World Press Release, "GSM Association Agreement with SkyPhone to use TAP for Billing makes Calling from Aircraft Simple", <a href="http://www.gsm.org/news/press_releases_04.html">http://www.gsm.org/news/press_releases_04.html</a> , August 1999 |
|                      | Fernandez et al., "Le TFTS Alcatel 9810: un systemme europeen de communications air-sol", Commutation et Transmission, Vol. 13, No. 4, Sotelec, Paris, France, 1991, pp. 5-16.  |
|                      | BTtoday NEWSDESK website, "Lift off for BT in-flight GSM service", <a href="http://today.intra.bt.com/art6594.html">http://today.intra.bt.com/art6594.html</a> , July 2000  |
|                      | Beresford, "Office in the sky is now ready for take off", BT today, January 2000, p. 4.   |

|                      |                 |
|----------------------|-----------------|
| Examiner's Signature | Date Considered |
|----------------------|-----------------|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Date Mailed: April 22, 2002

APR 22 2002

Sheet 2 of 2

**FORM 1449 (S&J Version)**

|  |                             |
|--|-----------------------------|
| FORM 1449 (S&J Version)                                  | Docket No.: 11696.004       |
| <b>INFORMATION DISCLOSURE STATEMENT<br/>BY APPLICANT</b> | Applicant: CLARKE et al.    |
|  | Application No.: 10/069,223 |
|  | Filing Date: 08/10/2000     |
|  | Examiner: _____             |
|  | Group Art Unit: _____       |

## **U.S. PATENT DOCUMENTS**

## **FOREIGN PATENT DOCUMENTS**

| Examiner's Initials* | Document No. | Date<br>MM/YYYY | Country                   | Class | Subclass | Translation |    |
|----------------------|--------------|-----------------|---------------------------|-------|----------|-------------|----|
|                      |              |                 |                           |       |          | Yes         | No |
|                      | EP 0 936 829 | 08/1999         | Europe                    |       |          |             |    |
|                      | 2,282,299    | 03/1995         | United Kingdom            |       |          |             |    |
|                      | WO 97/36442  | 10/1997         | PCT                       |       |          |             |    |
|                      | EP 0 915 577 | 05/1999         | Europe                    |       |          | X           |    |
|                      | 2,773,931    | 07/1999         | France (see US 6,269,243) |       |          |             | X  |
|                      | EP 0 838 909 | 04/1998         | Europe (see US 5,887,258) |       |          |             | X  |
|                      | EP 0 932 266 | 07/1999         | Europe (see US 6,269,243) |       |          |             | X  |
|                      | EP 0 920 147 | 06/1999         | Europe                    |       |          | X           |    |
|                      |              |                 |                           |       |          |             |    |
|                      |              |                 |                           |       |          |             |    |
|                      |              |                 |                           |       |          |             |    |
|                      |              |                 |                           |       |          |             |    |
|                      |              |                 |                           |       |          |             |    |

## **OTHER DOCUMENTS**

|                      |  |
|----------------------|--|
| Examiner's Initials* | Include author, title of article, title of item (book, journal, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. |
|                      | International Search Report for PCT/IB01/00830   |
|                      | International Search Report for PCT/GB00/03074   |
|                      | International Search Report for PCT/GB00/03087   |
|                      | International Search Report for PCT/IB01/00811   |
|                      | International Search Report for PCT/GB00/03088   |
|                      | International Search Report for PCT/IB01/00802   |
|                      |  |

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| Examiner's<br>Signature |  | Date Considered |  |
|-------------------------|--|-----------------|--|

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.